

**Remarks**

The Office Action mailed September 15, 2003 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1, 2, 5-22, 24-39, and 41 are now pending in this application. Claims 2, 3, 23, and 40 have been canceled. Claims 1-41 stand rejected.

The objection to the claims is respectfully traversed. Specifically, the second Claim 23 on page 15, line 5 has been renumbered as Claim 24. Accordingly, Applicant respectfully requests the objection to the claims be withdrawn.

The rejection of Claims 3, 24, 38, and 40 under 35 U.S.C. § 112 is respectfully traversed. Claims 3 and 40 have been canceled. Claim 24 depends from independent Claim 1 which has been amended to provide antecedent basis for Claim 24. Claim 40 depends from independent Claim 21 which has been amended to provide antecedent basis for Claim 40. Accordingly, Applicant respectfully requests the Section 112 rejections of Claims 3, 24, 38, and 40 be withdrawn.

The rejection of Claims 21-22, 24-28, 38, and 41 under 35 U.S.C. § 102(b) as being anticipated by Borghesi et al. (U.S. Pat. No. 5,950,169) is respectfully traversed.

Borghesi et al. describe a system 28 used by members of an insurance provider for managing and processing insurance claims work flow for claims filed by insured owners. The system includes at least one remote computer located at various locations within the insurance provider, including an insurance home office 30, a local claims office 32, and an auditor 34. Each computer 30, 32, and 34 is coupled to a communication server 36. The server maintains a database all information relating to a given claim, including vehicle inspection data, damage estimates, repair estimates, and salvage disposition information. Moreover, the system includes a total loss information tab that contains information on total loss valuation such as general vehicle by year, model, etc. The total loss value is an estimated value assigned to a damaged vehicle to generally determine if the cost to repair exceeds the total value of the vehicle.

If the total loss value is greater than an estimate of the repair, then a decision may be made to repair a damaged vehicle. Thus, the total loss value is used to help determine

whether the insured vehicle is repaired, or whether an owner of the vehicle is paid a settlement value for the vehicle. More specifically, the system enables an internal user of the insurance provider, such as a claims adjuster, a repair technician, or another member of the insurance provider, to compare estimated costs between original manufactured parts and recycled parts by selecting an estimate tab. Notably however, such information is not downloaded to the insured owner, but rather is used internally by the insurance providers to determine whether the insured vehicle is repaired, or whether an owner of the vehicle is paid a settlement value for the vehicle.

Claim 21 recites a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. The system comprises “a device...a server connected to said device and configured to receive specification information data about the jewelry item to be replaced via said device...said server further configured to identify stored product information data that matches item information data entered into the server, download product information to the user to enable the insured user to select a replacement item from the downloaded product information.”

Borghesi et al. do not describe nor suggest the recitations of Claim 21. Specifically, Borghesi et al. do not describe nor suggest a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. Rather, Borghesi et al. describe a system that is used by internal users of an insurance provider to manage and process insurance claims work flow for claims filed by insured owners regarding their insured vehicles. Moreover, Borghesi et al. do not describe nor suggest a server that downloads product information to the insured user to enable the user to select a replacement item from the downloaded product information. Rather, the system described in Borghesi et al. does not download information and is not configured to enable an insured user, external to the insurance provider, to select a replacement item. Accordingly, for at least the reasons set forth above, Claim 21 is submitted to be patentable over Borghesi et al.

Claims 22, 24-28, 38, and 41 depend from independent Claim 21. When the recitations of Claims 22, 24-28, 38, and 41 are considered in combination with the recitations of Claim 21, Applicant submits that dependent Claims 22, 24-28, 38, and 41 likewise are patentable over Borghesi et al.

For the reasons set forth above, Applicant respectfully requests that the Section 102 rejections of Claims 21-22, 24-28, 28, and 41 be withdrawn.

The rejection of Claims 39-40 under 35 U.S.C. § 103 as being unpatentable over Borghesi et al. is respectfully traversed

Borghesi et al. is described above. Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, the mere assertion that it would have been obvious to one of ordinary skill in the art to have modified Borghesi et al. to obtain the claimed recitations of the present invention does not support a prima facie obvious rejection. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art and the Applicant given the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.

Furthermore, in contrast to the assertion within the Office Action, Applicant respectfully submits that it would not be obvious to one skilled in the art to have modify Borghesi et al. because the Examiner has not pointed to any prior art that teaches or suggests to modify Borghesi et al. to obtain the claimed invention, other than Applicant's own teaching. Only the conclusory statement that "it would have been obvious to one of ordinary skill in the art to allow the teaching for Borghesi to include the feature of displaying the photograph..." suggests modifying Borghesi et al. Applicant respectfully submits however, that the cited art teaches away from the present invention. More specifically, none of the cited art, including Borghesi et al., describes or suggests a server that downloads product information about a replacement jewel item to the insured user to enable the insured user to select a replacement item from the downloaded product information.

Moreover, notwithstanding the propriety of the rejection, Applicant nonetheless submits that Claims 39-40 are patentable over Borghesi et al. Specifically, Claims 39 and 40 depend from Claim 21 which recites a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. The system comprises "a device...a server connected to said device and configured to receive specification information data about the jewelry item to be replaced via said device...said server further configured to identify stored product information data that matches item information data entered into the

server, download product information to the user to enable the insured user to select a replacement item from the downloaded product information.”

Borghesi et al. do not describe nor suggest the recitations of Claim 21. Specifically, Borghesi et al. do not describe nor suggest a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. Rather, Borghesi et al. describe a system that is used by internal users of an insurance provider to manage and process insurance claims work flow for claims filed by insured owners regarding their insured vehicles. Moreover, Borghesi et al. do not describe nor suggest a server that downloads product information to the insured user to enable the user to select a replacement item from the downloaded product information. Rather, the system described in Borghesi et al. does not download information and is not configured to enable an insured user, external to the insurance provider, to select a replacement item. Accordingly, for at least the reasons set forth above, Claim 21 is submitted to be patentable over Borghesi et al.

Claim 40 has been canceled. Claim 39 depends from independent Claim 21. When the recitations of Claim 39 are considered in combination with the recitations of Claim 21, Applicant submits that dependent Claim 39 likewise is patentable over Borghesi et al.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejections of Claims 39 and 40 be withdrawn.

The rejection of Claims 1-20, 23, and 29-37 under 35 U.S.C. § 103 as being unpatentable over Borghesi et al. in view of Frankel et al. (U.S. Pat. No. 6,449,661) is respectfully traversed

Borghesi et al. is described above. Frankel et al. describe a business model for maintaining a data base of missing/stolen items and missing persons/fugitives. Within the model, a user accesses the database through an internet portal and either posts information or inquires regarding stored information. In one embodiment, an automated recovery flowchart 100 is implemented, in which a user may seek missing/stolen items. In another embodiment, information regarding the missing/stolen item is entered as used as the basis for a competitive bidding process 405 used to procure the lowest bid through an auction, in which the lowest bid is automatically selected as the source for the replacement item. Notably, Frankel et al.

do not describe nor suggest downloading information to enable an insured user, external to the insurance provider, to select a replacement item.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Borghesi et al. nor Frankel et al., considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Frankel et al. with Borghesi et al. because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicant's own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time the invention to allow the insured item of Borghesi to include jewelry..." suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Borghesi et al. is cited for its teaching of a method for

replacing an insured item using a web-based system, and Frankel et al. is merely cited for its teaching of including the feature of downloading information related to the product. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection be withdrawn.

In addition, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Borghesi et al. nor Frankel et al. considered alone or in combination, describe or suggest a server that downloads product information about a replacement jewel item to the insured user to enable the insured user to select a replacement item from the downloaded product information.

If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicants respectfully submit that Frankel et al. and Borghesi et al., teach away from the present invention, and as such, there is no suggestion or motivation to combine Frankel et al. with Borghesi et al. to produce the claimed invention. Specifically, in contrast to the present invention, Frankel et al. describes a system in which an insured user may either seek missing/stolen items, or attempt to replace the items through a competitive bidding process in which the lowest bid is automatically selected as the source for the replacement item, and in further contrast to Frankel et al. and to the present invention, Borghesi et al. describes a system which enables an insurance provider to maintain and track a claim through the insurance process without enabling the insured user to select a replacement item during the claim process.

Accordingly, and to the extent understood, no combination of Borghesi et al. and Frankel et al. describes or suggests the claimed invention. Specifically, Claim 1 recites a method for replacing insured items of an insured user using a web-based system including a server and at least one device connected to the server via a network, wherein the method comprises "receiving at the server specification information about the item to be

replaced...comparing the received item specification information with information pre-stored within the server...downloading information related to the product...prompting the insured user to select at least one replacement item from the downloaded information.”

Neither Borghesi et al. nor Frankel et al., considered alone or in combination, describe or suggest a method for replacing insured items of an insured user using a web-based system including a server and at least one device connected to the server via a network, wherein the method includes receiving at the server specification information about the item to be replaced, comparing the received item specification information with information pre-stored within the server, and downloading information related to the product, in combination with prompting the insured user to select at least one replacement item from the downloaded information. Specifically, no combination of Borghesi et al. and Frankel et al. describes or suggests a method wherein the system prompts the insured user to select at least one replacement item from the downloaded information. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Borghesi et al. in view of Frankel et al.

Claims 3 and 4 have been canceled. Claims 2, and 5-20 depend from independent Claim 1. When the recitations of Claims 2 and 5-20 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2 and 5-20 likewise are patentable over Borghesi et al. in view of Frankel et al.

Claim 21 recites a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user. The system comprises “a device...a server connected to said device and configured to receive specification information data about the jewelry item to be replaced via said device...said server further configured to identify stored product information data that matches item information data entered into the server, download product information to the user to enable the insured user to select a replacement item from the downloaded product information.”

Neither Borghesi et al. nor Frankel et al., considered alone or in combination, describe or suggest a system for facilitating selection of an item by an insured user to replace an insured jewelry item of the insured user, wherein the server is configured to download product information to enable the insured user to select a replacement item from the downloaded product information. Specifically, no combination of Borghesi et al. and Frankel et al. describes or suggests a system which enables an insured user to select a replacement

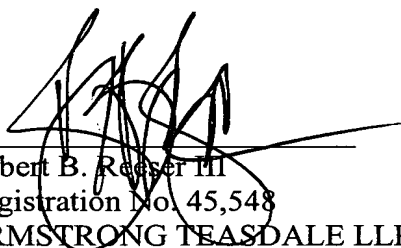
item from downloaded product information. For at least the reasons set forth above, Claim 21 is submitted to be patentable over Borghesi et al. in view of Frankel et al.

Claim 23 has been canceled. Claims 29-37 depend from independent Claim 21. When the recitations of Claims 29-37 are considered in combination with the recitations of Claim 21, Applicant submits that dependent Claims 29-37 likewise are patentable over Borghesi et al. in view of Frankel et al.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-20, 23, and 29-37 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Robert B. Reiser III  
Registration No. 45,548  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070